

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed July 21, 2004. At the time of the Office Action, Claims 1-15 were pending in this Application. Claims 1-15 were rejected. Claims 1-11 have been amended to further define various features of Applicant's invention. Claims 12-15 have been cancelled without prejudice or disclaimer. Claims 16-19 have been added to more distinctly claim the invention. Applicant respectfully requests reconsideration and favorable action in this case.

Priority

Applicant appreciates Examiner's acknowledgement of Applicant's claim for foreign priority based on an application filed in Germany January 11, 2001 and the PCT Office January 9, 2002. In accordance with 37 C.F.R. 1.55, Applicant intends to submit a certified copy of the aforementioned priority German application and a copy of the PCT application upon receipt of favorable action in the present application and prior to payment of any issue fees.

Rejections under 35 U.S.C. §112

Claims 1-11 and 14-15 were rejected by the Examiner under 35 U.S.C. §112, second paragraph, as being indefinite and failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant amends Claims 1-11 to overcome these rejections and respectfully requests full allowance of Claims 1-11 as amended. Claims 14-15 have been cancelled.

Rejections under 35 U.S.C. §103

Claims 1-15 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,611,372 issued to Ludwig Bauer et al. ("Bauer et al.") in view of U.S. Patent 4,805,490 issued to Reece R. Fuehrer et al. ("Fuehrer et al.") and further in view of U.S. Patent 6,160,708 issued to Josef Loibl et al. ("Loibl et al."). Applicant respectfully traverses and submits the now claimed invention is patentably distinct over these references.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, according to § 2143 of the Manual of Patent Examining Procedure, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Here it is respectfully submitted that the Examiner has not established a *prima facie* case of obviousness. Indeed, the Examiner has used the Applicant's claims as a template from which to review the prior art and to pick various features of Applicant's invention from various, here, 3 references. None of these references are remotely related to the present invention which provides a heretofore unknown "integrated hydraulic cooling fluid/signal and power distribution device" for motor vehicle gearboxes.

New claim 16 has been submitted to distinctly claim the invention, and the Applicant respectfully directs the Examiner's attention to claim 16. None of the art cited teach, disclose, or suggest a device as now claimed. The primary reference Bauer as the Examiner correctly notes "is silent as to channels extending for distribution of hydraulic fluid." Consequently, it is axiomatic that Bauer is silent as to "hydraulic fluid channels" for cooling an electronic circuit of an electronic control unit for a motor vehicle gearbox. Likewise, Bauer is silent as to conductors which are structurally integrated on or in a plastic plate as claimed. Indeed, Bauer teaches "the conductor tracks 49 consist of punched sheet-metal parts 50 which are arranged countersunk with respect to the adjacent surface 57 of the printed circuit board 28 and are secured in corresponding receiving grooves 82 of the printed circuit board 28." (Col. 7, lines 56-61) The conductors claimed are not integrated with a "circuit board" but with the plate which may communicate with the electronic control unit via a flexible circuit board, for example. Thus, Bauer, it is submitted, fails to teach the integrated conductors of the present invention.

Fuehrer was cited for disclosing "a hydraulic fluid distribution plate 21 with channel 70 extending for distribution of hydraulic fluid." First, Fuehrer refers to "68, 70, and 72" as "passages" not "channels." And Fuehrer's passages are certainly not utilized to distribute a fluid to cool electronics. Indeed, there are no electronics shown that are located in such a relationship to be cooled by any fluid flowing through Fuehrer's "passages". And thus, Fuehrer's plate is not adapted with channels running therethrough for cooling electronics via a fluid passing therethrough. In fact, Fuehrer, like Bauer, does not mention utilizing a fluid to cool electronics, much less Applicant's specifically claimed device.

Loibl was cited for disclosing a plastic plate. Loibl is owned by the assignee of the present application, and also does not disclose cooling of electronics with a fluid, or an integrated plate having cooling fluid channels and integrated conductors. Thus, Applicant submits the cited combination, even if combined, which Applicant does not concede is proper, would not render the elements of the presently claimed invention. Consequently, the Applicant respectfully requests favorable action in relation to claims 1-11 and new claims 16-19.

Change of Correspondence Address

Applicant encloses a Change of Correspondence Address and respectfully requests that all papers pertaining to the above-captioned patent application be directed to Customer No. 31625 and all telephone calls should be directed to Bruce W. Slayden II at 512.322.2606.

CONCLUSION

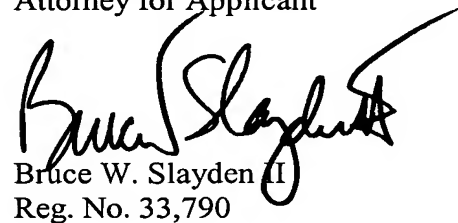
Applicant has now made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicant respectfully requests reconsideration of claims 1, 3, 6, and 9-10 as amended.

Applicant believes there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees to Deposit Account No. 50-2148 of Baker Botts L.L.P. in order to effectuate this filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.322.2606.

Respectfully submitted,

BAKER BOTTS L.L.P.
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SEND CORRESPONDENCE TO:

Baker Botts L.L.P.

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Date: 10/21/04

Attachment(s):

1. Change of Correspondence Address Form